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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221141
Party	Defendant JS Products, Inc.
Correspondence Address	DAVID A STALL LAW OFFICE OF DAVID A STALL 2152 DUPONT DR , STE 140 IRVINE, CA 92612-1323 UNITED STATES
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Stanley Logistics, LLC,)	
)	
Opposer,)	Opposition No. 91221141
)	
v.)	Serial No. 86/321,980
)	
JS Products Inc.,)	
)	
Applicant.)	
)	

APPLICANT’S ANSWER

Box TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Applicant, JS Products Inc. (“Applicant”), by and through its attorneys, hereby answers the Notice of Opposition filed by Stanley Logistics, LLC (“Opposer”).

ANSWERS

1. Stanley Logistics, LLC is a wholly-owned subsidiary of Stanley Black & Decker, Inc. (collectively "Stanley"). Stanley is renowned in the U.S. and around the world as a leading manufacturer and marketer of tools, tool kits, security products, and a wide variety of other products.

RESPONSE:

Applicant lacks sufficient information to form a belief as to the truth of the allegations of paragraph 1 of the Notice of Opposition and therefore denies the same.

2. For more than 65 years Stanley and its predecessors-in-interest have used the trademark PROTO, and marks that incorporate PROTO, in connection with hand and power tools, tool storage products, and a wide variety of related goods and services. Stanley owns several federal trademark registrations for its PROTO marks, including the following:

Reg. No.	Reg. Date	Mark	Goods
0501030	July 13, 1948	PROTO	Pliers, end wrenches and sockets, in Class 8
0530257	Sept. 5, 1950	PROTO	Tools-namely, adapters, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring plier, brake tools, cape chisels, chisels, cold chisels, connecting rod sockets, crowfoot wrenches, diamond point chisels, drag link tools, L handles, flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, pneumatic wrench sockets, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdriver sockets, screwdrivers, socket handles, socket racks, socket wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches
0555093	Feb. 19, 1952	PROTO	Tools-namely-brake gauges, feeler gauges, ignition gauges, and thickness gauges, in Class 9
0889361	Apr. 14, 1970	PROTO	Compression testers, in Class 9
0954749	Mar. 13, 1973	PROTO	Containers for tools-namely, portable tool boxes, chests and cabinets, in Class 6
1739488	Dec. 15, 1992	PROTO	manually operated hand tools; namely, sockets, ratchets, universal joints, wrenches, torque wrenches, c-clamps, punches, pry bars, chisels, pliers, cutters, wire strippers, snips, utility knives, screwdrivers, nut drivers, hex bits and hex keys, hammers, pullers, saws, inspection mirrors, files and parts thereof, in Class 8; and feeler and thickness gauges and measuring instruments; namely, tape rules, in Class 9
4384740	Aug.13, 2013		Power impact wrenches and power torque drivers, in Class 7
4403918	Sept.17, 2013		Pneumatic wrench sockets, in Class 7; Hand tools, namely, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring pliers, universal brake adjusting tools, cape chisels, chisels, cold chisels, connecting rod sockets, crowfoot wrenches, diamond point chisels, L handles,

			flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdrivers, screwdriver sockets, socket handles, socket racks, socket adapter heads, drag link socket head adapters, wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches, pliers, end wrenches and sockets, in Class 8
4502145	Mar.25, 2014	PROTO	Metal containers for tools sold empty, namely, portable tool boxes and chests, in Class 6; Containers for tools, namely, portable tool boxes and chests sold filled with hand tools, in Class 8; Non-metal containers for tools sold empty, namely, portable tool boxes and chests; containers for tools, namely, cabinets, in Class 20
4384784	Aug.13, 2013	PROTO	Power impact wrenches and power torque drivers, in Class 7
4426057	Oct.29, 2013	PROTO (Td)	Metal containers for tools sold empty, namely, portable tool boxes and chests, in Class 6
4396897	Sept. 3, 2013	PROTO (Td)	Power impact wrenches and power torque drivers, in Class 7
4426058	Oct. 29, 2013	PROTO (Td)	Pneumatic wrench sockets, in Class 7; Hand tools, namely, adapters to affix radio frequency identification chips to tools, awls, utility bars, battery terminal pullers, bearing pullers, bending bars, box wrenches, brake spring pliers, cape chisels, chisels, cold chisels, connecting rod sockets, crowfoot wrenches, diamond point chisels, L handles, flare nut wrenches, flex handles, gear pullers, hacksaws, hinge handles, offset box wrenches, open end wrenches, pin handles, pinion puller bars, pipe extractors, pipe wrenches, pitman arm pullers, prick punches, pry bars, pullers, punches, ratchets, rim wrenches, ripping chisels, rivet cutters, rolling head bars, scrapers, screw extractors, screwdriver sockets, screwdrivers, socket handles, socket racks, socket wrenches, combination wrenches, star drills, stud pullers, torque wrenches, tubing expanders, universal joints, universal sockets, wheel pullers, wood chisels, wrench pliers, wrenches, pliers, end wrenches and sockets, in Class 8.

RESPONSE:

Applicant admits that the USPTO TESS records reflect the alleged thirteen trademark registrations as being owned by Opposer, but otherwise Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations of paragraph 2 of the Notice of Opposition and, therefore, denies same.

3. Many of these registrations are incontestable and provide conclusive evidence of Stanley's registration of the PROTO marks, Stanley's ownership of the marks, and of Stanley's exclusive right to use the marks in commerce on or in connection with the goods specified in the registrations.

RESPONSE:

Applicant admits that the USPTO TESS records reflect that some of the alleged thirteen trademark registrations are incontestable, but otherwise Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations of paragraph 3 of the Notice of Opposition and therefore denies the same.

4. Stanley's rights in the PROTO marks are senior to any trademark rights Applicant may claim in the mark PROTOCOL.

RESPONSE:

Applicant admits that the USPTO TESS records reflect that Opposer's alleged trademark registrations for PROTO set forth in paragraph 2 of the Notice of Opposition have filing dates earlier than that of Applicant's PROTOCOL application, but Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations of paragraph 4 of the Notice of Opposition and therefore denies the same.

5. For decades Stanley has expended substantial resources and money marketing, advertising, and promoting the PROTO marks throughout the United States in connection with a wide range of hand and power tools, tool storage products, and related goods and services.

RESPONSE:

Applicant lacks sufficient information to form a belief as to the truth of the

allegations of paragraph 5 of the Notice of Opposition and, therefore, denies the same.

6. By reason of its extensive marketing, advertising, and promotion, Stanley's PROTO marks have become uniquely associated with Stanley.

RESPONSE:

Applicant lacks sufficient information to form a belief as to the truth of the allegations of paragraph 6 of the Notice of Opposition and therefore denies the same.

7. Stanley's PROTO marks have become well-known and famous as distinctive indicators of the origin of Stanley's goods and services, and the PROTO marks are valuable symbols of Stanley's goodwill.

RESPONSE:

Applicant denies that Opposer's PROTO marks are famous within the meaning of 15 USC §1125(c), but lacks sufficient information to form a belief as to the truth of the remaining allegations of paragraph 7 of the Notice of Opposition and therefore denies the same.

8. The PROTO marks are fanciful, arbitrary, inherently distinctive, and therefore strong and entitled to a broad scope of protection.

RESPONSE:

Applicant denies the allegations of paragraph 8 of the Notice of Opposition.

9. Applicant has done business with Stanley and was aware of Stanley's PROTO marks when Applicant adopted its PROTOCOL mark but, notwithstanding Stanley's prior rights, Applicant is seeking to register the mark PROTOCOL for the following hand tools:

Hand Tools, namely Axes, Clamps, Knives, Saws, Saw Blades, Cutters, Punches, Chisels,

Pliers, Screwdrivers, Nut Drivers, Hammers, and Drill Bits, in Class 8

RESPONSE:

Applicant admits that it has done business with Stanley Black & Decker, Inc. or a predecessor thereof. Applicant admits that it is seeking to register the mark PROTOCOL for the above referenced goods in Class 8, and admits that it was aware of Opposer's PROTO marks when adopting its PROTOCOL mark, but denies that Applicant's PROTOCOL mark is confusingly similar to or dilutive of Opposer's PROTO mark. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations of paragraph 9 of the Notice of Opposition and therefore denies the same.

10. The mark PROTOCOL is substantially and confusingly similar to Stanley's PROTO marks.

RESPONSE:

Applicant denies the allegations of paragraph 10 of the Notice of Opposition.

11. The goods identified in the PROTOCOL Application are highly related or identical to the goods Stanley provides under its PROTO marks, and the goods protected under Stanley's federal trademark registrations for the PROTO marks.

RESPONSE:

Applicant admits that USPTO TESS records reflect that some of the goods covered by Opposer's PROTO registrations are overlapping with Applicant's goods in its PROTOCOL Application, but Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations of paragraph 11 of the Notice of Opposition and therefore denies the same.

12. Stanley is not related to Applicant and has not authorized Applicant to use or register the Disputed Mark.

RESPONSE:

Applicant admits the allegations of paragraph 12 of the Notice of Opposition, and in further answer, denies that any authorization is or was required.

13. Stanley believes that it will be damaged by the registration of the Disputed Mark.

RESPONSE:

Applicant denies the allegations of paragraph 13 of the Notice of Opposition.

COUNT I- LIKELIHOOD OF CONFUSION-§ 2(d)

14. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 13 above.

RESPONSE:

Applicant hereby incorporates by reference its answers to paragraphs 1 through 13 above.

15. The mark PROTOCOL so resembles Stanley's PROTO marks that Applicant's use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and will injure and damage Stanley and the goodwill and reputation symbolized by Stanley's PROTO marks.

RESPONSE:

Applicant denies the allegations of paragraph 15 of the Notice of Opposition.

16. Applicant's goods are highly-related or identical to the goods and services of Stanley such that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Stanley or that Applicant is in some way connected with, sponsored by, or affiliated with Stanley, all to Stanley's irreparable damage.

RESPONSE:

Applicant admits that some of the goods in its opposed application are overlapping with the goods recited in some of Opposer's alleged PROTO registrations, but otherwise denies the remaining allegations of paragraph 16 of the Notice of Opposition.

17. Likelihood of confusion is enhanced in this case by the fame of Stanley's PROTO marks and by the fact that consumers associate Stanley's PROTO marks with goods and services sold, approved, or endorsed by Stanley.

RESPONSE:

Applicant denies the allegations of paragraph 17 of the Notice of Opposition.

18. Likelihood of confusion is enhanced in this case by the fact that the parties' goods are marketed and sold through the same trade channels to the same purchasers and classes of purchasers.

RESPONSE:

Applicant denies the allegations of paragraph 18 of the Notice of Opposition.

COUNT II- DECEPTION/FALSE SUGGESTION OF CONNECTION-§ 43(a)

19. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 18 above.

RESPONSE:

Applicant hereby incorporates by reference its answers to paragraphs 1 through 18 above.

20. Applicant's mark PROTOCOL so closely resembles Stanley's PROTO marks that it is likely to cause deception in violation of Section 2(a) of the Trademark Act in that the mark misdescribes the origin of the goods, purchasers are likely to believe that the misdescription actually describes the origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Stanley's goods and services.

RESPONSE:

Applicant denies the allegations of paragraph 20 of the Notice of Opposition.

21. Applicant's mark PROTOCOL so closely resembles Stanley's PROTO marks that it falsely suggests a connection with Stanley in violation of Section 2(a) of the Trademark Act because Applicant's mark points uniquely to Stanley, and purchasers will assume that goods offered under Applicant's mark are connected with Stanley.

RESPONSE:

Applicant denies the allegations of paragraph 21 of the Notice of Opposition.

22. When Applicant's mark is used on the goods covered under its application, Applicant's mark will cause purchasers to mistakenly assume that Stanley is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting Applicant's mark to be used in connection with such goods.

RESPONSE:

Applicant denies the allegations of paragraph 22 of the Notice of Opposition.

23. Applicant's mark PROTOCOL is deceptive in that it falsely suggests a connection with, or approval by, Stanley.

RESPONSE:

Applicant denies the allegations of paragraph 23 of the Notice of Opposition.

24. Use and registration of the mark PROTOCOL by Applicant will deprive Stanley of the ability to protect its reputation, persona, and goodwill.

RESPONSE:

Applicant denies the allegations of paragraph 24 of the Notice of Opposition.

25. Likelihood of damage to Stanley's goodwill is enhanced by the fact that many of the same customers and prospective customers will encounter both the PROTO and PROTOCOL marks and those that encounter defects in the quality of Applicant's goods will attribute those defects to Stanley, thereby injuring Stanley's reputation and goodwill.

RESPONSE:

Applicant denies the allegations of paragraph 25 of the Notice of Opposition.

COUNT III- DILUTION-§ 43(c)

26. Stanley hereby incorporates by reference the allegations contained in paragraphs 1 through 25 above.

RESPONSE:

Applicant hereby incorporates by reference its answers to paragraphs 1 through 25 above.

27. Stanley's PROTO marks have been widely used and extensively publicized in the United States and have become well-known and famous within the meaning of the Lanham Act§ 43(c) as

a distinctive symbol of Stanley's goodwill.

RESPONSE:

Applicant denies that Opposer's PROTO marks are famous within the meaning of 15 USC §1125(c), but lacks sufficient information to form a belief as to the truth of the remaining allegations of paragraph 27 of the Notice of Opposition and therefore denies the same.

28. Stanley's PROTO marks were well-known and famous before Applicant filed its application for or made any use of the mark PROTOCOL.

RESPONSE:

Applicant denies the allegations of paragraph 28 of the Notice of Opposition.

29. Applicant's conduct is likely to cause an association arising from the similarity between the marks PROTO and PROTOCOL that impairs the distinctiveness of Stanley's mark PROTO.

RESPONSE:

Applicant denies the allegations of paragraph 29 of the Notice of Opposition.

30. The use or registration of Applicant's mark PROTOCOL will tarnish the goodwill of Stanley's PROTO marks and lessen the capacity of Stanley's PROTO marks to identify and distinguish Stanley's goods and services.

RESPONSE:

Applicant denies the allegations of paragraph 30 of the Notice of Opposition.

31. Likelihood of confusion, dilution, and deception is further enhanced here by the fact that the parties' goods and services will be advertised and provided through the same trade channels

and to the same classes of prospective purchasers.

RESPONSE:

Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations of paragraph 31 of the Notice of Opposition and therefore denies the same.

32. Likelihood of confusion, dilution and deception is further enhanced here by the fact that the goods covered under Applicant's PROTOCOL application are closely related or identical to those provided by Stanley under its PROTO marks.

RESPONSE:

Applicant admits that some the goods covered under Applicant's opposed application are overlapping with the goods recited in some of Opposer's alleged PROTO registrations, but otherwise denies the allegations of paragraph 32 of the Notice of Opposition.

33. By reason of the foregoing, Stanley asserts that it will be damaged by the registration of Applicant's mark PROTOCOL and hereby opposes the Application under 15 U.S.C. § 1052.

RESPONSE:

Applicant denies the allegations of paragraph 33 of the Notice of Opposition.

WHEREFORE, Applicant prays that the subject opposition be dismissed and a Notice of Allowance be issued in connection with its application Serial No. 86/321,980.

Respectfully submitted,

By: /Paul G. Juettner/

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Tanja Proehl
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S ANSWER** has been served upon the following counsel for Opposer:

James R. Davis, II
Arent Fox LLP
1717 K Street, NW
Washington, DC 20006-5344

by First Class mail, on this 27 day of April, 2015.

By: /Paul G. Juettner/

Paul Juettner
Attorney for APPLICANT